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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,039	02/01/2001	Son Nguyen Kim	49320	7940

26474 7590 09/04/2003

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/04/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,039

Applicant(s)

KIM ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time and request for continued examination under 37 CFR 1.114 filed 08/18/03. Claims 1-19 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 7-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to a polymer that is consisting of parts (a), (b) and (c) and because the polymer is consisting of (a), (b) and (c), other components/ingredients are excluded from the polymer. Cosmetic preparations contain carriers that are excluded from instant claim 1. Instant claim 7 recites that inclusion of the polymer in a cosmetic preparation and a cosmetic preparation does not have antecedence from claim 1.

The rejection under 35 U.S.C. 112, second paragraph may be overcome by:

- i) Amending claim 7 to an independent claim where the polymer of claim 1 if intended to be present in the cosmetic preparation may be recited as it is recited in claim 1 as consisting of the parts (a), (b) and (c), and
- ii) Amending claim 13 to an independent claim where the limitations of claim 1 may be recited as part (a) of the claim 13.

It is respectfully noted that the suggestion above is not an indication that claims 7-19 would be allowable if claims 7 and 13 are made independent.

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3. Claims 1-6 are allowable because the consisting language excludes other ingredients from the polymer.
4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Straub (EP 0 100 890) teaches a copolymer obtained by free radical copolymerization of an alkyl acrylate or methacrylate, water-soluble neutral nitrogen containing monomer, cation-group containing monomer and a 3 or 4 carbon unsaturated carboxylic acid. The polymer is obtained by free-radical copolymerization of 20-75% ethyl, n-butyl, tert-butyl or lauryl acrylate or methacrylate or mixtures thereof, 5-50% N-vinylpyrrolidone, N-vinylcaprolactam or mixture thereof, 1-25% n-vinylimidazole, 1-vinyl-2-methylimidazole or mixtures thereof and 1-25% of acrylic acid or methacrylic acid. The polymer has a K value of from 12-75 when measured in ethanol at 25 °C. The polymeric composition of Straub finds utility in hair sprays, fixatives, and auxiliaries in shampoos and setting compositions. See abstract. The claimed ranges lie inside the ranges taught in the prior art. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Pothhoff-Karl et al (US 5,132,417) teaches a copolymer of tert butyl acrylate and/or tert-butyl methacrylate obtained by free radical polymerization of from 20-90% tert-butyl acrylate and /or tert-butyl methacrylate, from 10-60% N-vinylpyrrolidone and from 0-30% C1-C20- alkyl acrylate, C1-C20 alkyl methacrylate, a C2-C4-hydroxyalkyl methacrylate or vinyl acetate or mixtures thereof (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
Patent Examiner
Tech. Center 1600

